UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,982	10/31/2003	Damon V. Danieli	13768.810.60	8851

47973 7590 03/13/2007
WORKMAN NYDEGGER/MICROSOFT
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER	
CROSS, ALAN	
ART UNIT	**PAPER NUMBER**
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/698,982	DANIELI ET AL.	
	Examiner	Art Unit	
	Alan Cross	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133): Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *1-28* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

> The oath or declaration is defective because:
> It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
>
> It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4,6-12,15-20,22,23,26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Kirmse et al. (US Pub #2002/0086732).

Regarding claim 1,19,27: Kirmse discloses a method for enabling a user to play an online game with a friend selected from a friends list of the user, comprising the steps of: (a) enabling the user to select a friend from the friends list of the user; (b) enabling the user to selectively do one of the following: (i) send an invitation to the friend selected from the friends list, to join the user in playing in an online game currently loaded for play by the user, even if the friend is currently playing a different online game (abstract); and (ii) join the friend in playing an online game being played by the friend, even if the friend is currently playing a different online game than the online game currently loaded for play by the user; (c) if the invitation was sent and was accepted by the friend, connecting the friend who was invited, in playing the online game currently loaded for play by the user; and (d) if the user chose to join the friend in playing, connecting the user to play the online game being played by the friend (pg. 1, 0008, pg. 4, 0044).

Regarding claim 2,4 ,20: Kirmse discloses the method of Claim 1, wherein if the user chose to join the friend in playing the online game being played by the friend, and if the online game currently loaded for play by the user is different than the online game currently being played by the friend, further comprising the step of: (a) causing data identifying the online game currently being played by the friend and a game session currently being played by the friend to be stored in a non-volatile storage; (b) prompting the user to load the online game currently being played by the friend (pg. 4, 0043); and (c) automatically comparing the online game being played by the friend as indicated by

the data stored in non-volatile storage with the online game just loaded by the user, and enabling the user to join in playing the online game being played by the friend if: (i) the online game just loaded by the user is the same as the online game currently being played by the friend; (ii) the current online opening for the user to play; and (iii) the online game concluded. game session of the friend has an session of the friend has not yet (pg. 3, 0035, pg. 4 0046)

Regarding claim 6,22: Kirmse discloses the method of Claim 1, wherein if the online game currently loaded by the user is the same as the online game currently being played by the friend selected from the friends list, the user and the friend are immediately connected in playing the online game if: (a) the friend accepts the invitation from the user and there is still an opening for the friend to play in any game session of the online game that was being played when the friend was invited to play; or (b) the user chooses to join in playing the online game currently being played by the friend and there is still an opening for the user to play in the game session that was active when the user chose to join the friend in playing the online game of the friend (pg. 4, 0040, pg. 5, 0051).

Regarding claim 7,23: Kirmse discloses the method of Claim 1, further comprising the step of displaying the invitation from the user to the friend (pg. 4, 0045).

Regarding claim 8,10,11: Kirmse discloses the method of Claim 1, further comprising the steps of." (a) enabling the user to host the online game and to determine parameters related to the play of the online game; and (b) enabling the user to selectively determine, as one of the parameters, that one or more openings for other

players to play the online game will be filled by friends included in the friends list of the user (pg. 5, 0058).

Regarding claim 9,25: Kirmse discloses the method of Claim 8, further comprising the step of enabling the user to send a plurality of invitations to friends included in the friends list of the user, to play the online game currently loaded by the user (pg. 4, 0039, pg 10, 0099).

Regarding claim 12: Kirmse discloses the method of Claim 1, further comprising the step of enabling the user to selectively add an online player to the friends list of the user by: (a) sending a request to the online player to add the online player to the friends list of the user; and (b) if the online player selectively accepts the request, automatically adding the online player to the friends list of the user, and automatically adding the user to the friends list of the online player (pg. 10, 0100).

Regarding claim 15: Kirmse discloses the method of Claim 1, further comprising the step of enabling the user to selectively add an online player to the friends list of the user by: (a) sending a request to the online player to add the online player to the friends list of the user; and (b) if the online player selectively accepts the request, automatically adding the online player to the friends list of the user, and automatically adding the user to the friends list of the online player (pg. 4, 0044, pg. 10, 0100).

Regarding claim 16: Kirmse discloses the method of Claim 1, further comprising the step of enabling the user to set a plurality of options that control an interaction between the friend selected in the friends list and the user during play of online games (pg. 5, 0058, pg. 10, 0101).

Regarding claim 17,26: Kirmse discloses the method of Claim 1, further comprising the step of displaying information related to online game play for each friend on the friends list (fig. 9, pg. 3, 0036).

Regarding claim 18: Kirmse discloses a memory medium on which are stored machine readable instructions for carrying out the steps of Claim 1 (pg. 2, 0029).

Regarding claim 28: Kirmse discloses a method for enabling a user to join a friend in playing an online game, comprising the steps of: (a) enabling the user to select a friend to join in playing the online game from a friends list of the user; (b) enabling the user to select an option to join the friend in playing the online game; (c) if the user has been using a different online game: (i) temporarily storing data identifying the online game that the friend is playing, while the user loads the online game currently being played by the fiiend; (ii) automatically accessing the data that were temporarily stored; and (iii) automatically connecting the user to play the online game currently being played by the friend; and (d) if the user has been using the same online game as the friend is currently playing, automatically connecting the user to play the online game currently being played by the friend (abstract, pg. 5, 0051, pg. 6,0060).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3,5,13,14,21,24 rejected under 35 U.S.C. 103(a) as being unpatentable over Kirmse.

Regarding claims 3,5,14,21,24: Kirmse teaches the method of Claim 2, and is fully capable wherein the data stored in the non-volatile storage are disregarded when the online game currently being played by the friend is loaded by the user, if more than a predefined interval of time has elapsed since the data identifying the online game and the online game session being played by the friend were stored in the non-volatile storage. It is well known in the art that from sending a invitation a certain time can elapse before it is disregarded as in a RSVP, or when you try to link to a website and it does not respond by timing out. It would have been obvious to one of ordinary skill in the art to have a predetermined time set for an invited users to respond so that the inviter would not wait indefinitely for a response.

Regarding claim 13: Kirmse teaches the method of Claim 12, except further comprising the step of enabling the user to cancel the request for the online player to be added to the friends list of the user if the online player has not yet accepted the request Where it is well known in the art to restrict communication between users if one user does not agree to communications with the other for privacy or not being bothered by unwanted solicitations. It would have been obvious to one of ordinary skill in the art to allow a user to keep unwanted users from contacting them or letting other users disturb them for there own privacy and state of mind.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gatz et al. (US Pub #2002/0049806) discloses a blocking list to keep unwanted users from contacting a users account.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cross whose telephone number is 571-272-5529. The examiner can normally be reached on 8-4 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ARC 571-272-5529

ROBERT E. PEZZUTO
SUPERVISORY PRIMARY EXAMINER